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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,498	09/16/2003	James Scott Anderson	453.1	2443

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JAMES SCOTT ANDERSON  
1214 HILLWOOD COURT SE  
ATLANTA, GA 30316-2660

EXAMINER

SILBERMANN, JOANNE

ART UNIT	PAPER NUMBER
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3611

DATE MAILED: 06/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/663,498	<b>Applicant(s)</b> ANDERSON, JAMES SCOTT	
	<b>Examiner</b> Joanne Silberman	<b>Art Unit</b> 3611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-7,10-17 and 20-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-7, 10-17, 20-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 10-13, 16 and 23-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Molee et al. US #5,829,832.

3. Molee et al. teach a label assembly including writing surface 28 (for receiving temporary and permanent indicia), semi-rigid core 30 (Figure 3) and slot 26. Slot 26 is positioned and sized to receive an edge of a generally planar surface. The orientation of the slot is generally parallel to the writing surface. Regarding the location of the writing surface, this surface in Molee et al. is considered to extend from the bottom of the words up over the top and down the back of the core. Therefore, the majority of this surface is above the edge. Additionally, if the wall of the container is short, then the majority of the writing surface extends beyond the edge when the edge is received within the slot. The assembly includes front and rear surfaces, as shown in Figures 1 and 2. The indicia are considered to be permanent.

4. Molee et al. do not teach the writing surface as being generally planar, however this is considered to be entirely a matter of design choice. Matters relating to ornamentation only, and having no mechanical function, cannot be relied on where claims are not directed to design but are structural claims. In re SEID, 73 USPQ 431

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(CCPA 1947) The writing surface being planar instead of as shown in Molee et al. does not appear to have any mechanical function. Also, the writing surface being planar does not appear to solve any stated problem or serve any particular purpose (other than provide a writing surface) and it appears that the surface of Molee et al. would perform equally well.

5. Molee et al. do not teach a plurality of slots, however this is considered to be a duplication of known parts. It has been held that mere duplication of the essential working parts of a device involves only routine skill in the art.

6. Molee et al do not teach a vinyl surface, however vinyl is old and well known. It would have been obvious to one of ordinary skill to utilize vinyl as an equivalent alternative if it is desired to place water-soluble indicia on the display.

7. Molee et al. do not specifically teach the method steps of the instant claims, however such methods would have been obvious to one of ordinary skill given the structure of Molee et al.

8. Claims 4-7 and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Molee et al. in view of Hutchens, US #5,581,921.

9. Molee et al. do not teach a projection, however displays including such projections are well known, as shown by Hutchens. Hutchens teaches a display including projection 6 having several straight surfaces and extending perpendicularly to surface 22 (Figure 3) having permanent indicia thereon. The projection is considered to be sized and shaped to prevent inadvertent erasure of the indicia. It would have been

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obvious to one of ordinary skill in the art to utilize such a projection on the device shown by Molee et al. so that the indicia may be more easily seen.

10. The methods steps would have been obvious to one of ordinary skill for the same reason as discussed above.

11. Claims 14 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Molee et al. in view of Roche et al. US #5,384,999.

12. Molee et al. do not teach a metallic core, however such a surface is well known in the art. Roche et al. teach a display including magnetic layer 14. It would have been obvious to one of ordinary skill in the art to utilize such a magnetic layer in the display of Molee et al. so that magnetic display elements may be used, as described in Roche et al. The methods would have been obvious as discussed above.

13. Claims 2, 15, 17 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Molee et al. in view of Schmeida, US #5,727,818.

14. Molee et al. do not teach a whiteboard, however this is well known in the art. Schmeida teaches a labeling system including a writing surface for dry erase markers and includes a transparent covering (see Abstract). It would have been obvious to one of ordinary skill to utilize whiteboard so that the display may be easily erased and changed, and a transparent cover to protect the display.

15. Molee et al. and Schmeida do not teach methods, however the method steps would have been obvious for the same reasons as above.

### ***Response to Arguments***

16. Applicant's arguments filed April 12, 2005 have been fully considered but they are not persuasive.

17. The new requirement that the writing surface be generally planar is addressed in the rejection. As for a majority of this surface extending above the wall of a container, this refers to the intended use of the writing surface. The container is not part of the claimed invention, therefore if a container having short sides is used, this limitation is met. Also, the examiner has defined the writing surface as that part that extends up and over the top of the core, thereby having the majority of this surface above the edge.

18. The use of more than one slot is considered to have been obvious to one of ordinary skill in the art, as discussed in the rejection.

19. Regarding the Hutchens reference, all of the structural elements of the claim have been met. The projection extends laterally and perpendicular to the surface, and therefore prevents inadvertent erasure.

20. Regarding the Roche reference, Roche teaches using a magnetic support for a display. Applicant argues that the references do not suggest any motivation for making the combination, however there is no requirement that a motivation be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 170 USPQ 209 (CCPA 1971). In this case, a magnetic support used with a display surface.

21. Applicant argues that Molee et al. and Schmeida do not teach a whiteboard as claimed, however, the claimed elements are shown as discussed in the above rejection. Regarding the motivation to combine, the disclosures taken together suggest a display

surface made of erasable whiteboard. The "film" is discussed in the Abstract of Scmeida (a transparent protective overlay).

***Conclusion***

22. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joanne Silbermann whose telephone number is 571-272-6653. The examiner can normally be reached on M-F 5:30 - 2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on 571-272-6651. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Joanne Silberman  
Primary Examiner  
Art Unit 3611

JS